

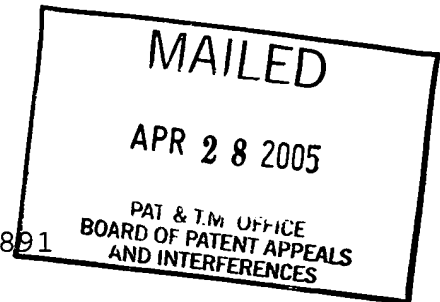
The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MIKA RINNE
and JUHA KALLIOKULJU

Appeal No. 2005-0369
Application No. 09/498,891



ON BRIEF

Before RUGGIERO, DIXON, and GROSS, Administrative Patent Judges.
RUGGIERO, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal from the Examiner's rejection of claims 1-24, which are all of the claims pending in the present application. An amendment filed January 2, 2004 concurrently with the original Appeal Brief was approved for entry by the Examiner.

The claimed invention relates to a method and apparatus for transferring information over a data connection according to a protocol stack in which first protocol layers and second protocol layers exist. A value of a protocol identifier is determined in accordance with the first protocol layers in the protocol stack and

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the protocol identifier is signaled to the second protocol layers in the protocol stack.

Representative claim 1 is reproduced as follows:

1. A method for transferring information over a data connection according to a protocol stack where certain first protocol layers and certain second protocol layers exist, comprising the steps of

creating a protocol identifier,

determining a value for said protocol identifier in accordance with the first protocol layers in said protocol stack and

signaling said protocol identifier to the second protocol layers in said protocol stack.

The Examiner relies on the following prior art:

Gleeson et al. (Gleeson)	5,446,736	Aug. 29, 1995
Amri et al. (Amri)	5,535,199	Jul. 09, 1996

W. Richard Stevens (Stevens), TCP/IP Illustrated, Volume 1, The Protocols, Addison Wesley, 21-3, 53 (1994).

Claims 1, 9-14, 16, 18, and 20 stand rejected under 35 U.S.C. § 112, second paragraph, as failing to particularly point out and distinctly claim the invention. Claims 1, 2, 6, 8-10, and 14-20 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Stevens. Claims 1, 7, 11, and 12 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Amri. Claims 20-24 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Gleeson. Claims

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3-5 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Stevens.

Rather than reiterate the arguments of Appellants and the Examiner, reference is made to the Briefs¹ and Answer for the respective details.

OPINION

We have carefully considered the subject matter on appeal, the rejections advanced by the Examiner, the arguments in support of the rejections and the evidence of anticipation and obviousness relied upon by the Examiner as support for the prior art rejections. We have, likewise, reviewed and taken into consideration, in reaching our decision, Appellants' arguments set forth in the Briefs along with the Examiner's rationale in support of the rejections and arguments in rebuttal set forth in the Examiner's Answer.

It is our view, after consideration of the record before us, that claims 1, 9-14, 16, 18, and 20 particularly point out the invention in a manner which complies with 35 U.S.C. § 112, second paragraph. We are also of the view that the Stevens reference

¹ The Appeal Brief (Supplemental) was filed April 26, 2004 (Paper No. 13). In response to the Examiner's Answer dated June 2, 2004 (Paper No. 14), a Reply Brief was filed August 4, 2004 (Paper No. 15), which was acknowledged and entered by the Examiner as indicated in the communication dated September 3, 2004 (Paper No. 16).

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fully meets the invention as set forth in claims 1, 2, 6, 8-10, and 14-20, the Amri reference fully meets the invention as set forth in claims 1, 7, 11, and 12, and the Gleeson reference fully meets the invention as set forth in claims 20-24. We are further of the opinion that the evidence relied upon and the level of skill in the particular art would have suggested to one of ordinary skill in the art the obviousness of the invention as recited in claims 3-5. Accordingly, we affirm-in-part.

We consider first the Examiner's 35 U.S.C. § 112, second paragraph, rejection of claims 1, 9-14, 16, 18, and 20 as failing to particularly point out and distinctly claim the invention. We note that the general rule is that a claim must set out and circumscribe a particular area with a reasonable degree of precision and particularity when read in light of the disclosure as it would be by the artisan. In re Moore, 439 F.2d 1232, 1235, 169 USPQ 236, 238 (CCPA 1971). Acceptability of the claim language depends on whether one of ordinary skill in the art would understand what is claimed in light of the specification. Seattle Box Co. v. Industrial Crating & Packing, Inc., 731 F.2d 818, 826, 221 USPQ 568, 574 (Fed. Cir. 1984).

With respect to the rejected claims, we find no ambiguity or lack of clarity in the existing claim language which employs the

word "certain" to refer to layers in a protocol stack. After reviewing Appellants' disclosure, it is apparent to us that the claim language refers to unidentified individual layers in the protocol stack, an interpretation which is in accord with the Examiner's own proffered definition (Answer, page 23), i.e., "of a specific but unspecified character" While the claims are perhaps broader by referring to unspecified layers rather than if particular protocol layers were specified and identified, no uncertainty or lack of specificity exists as asserted by the Examiner. Similarly, while the use of the terminology "generally" and "more detail" in claim 13 is a broad recitation, we find no ambiguity in the use of such language. The breadth of a claim is not to be equated with indefiniteness. In re Miller, 441 F.2d 689, 692, 169 USPQ 597, 600 (CCPA 1971).

It is our view that the skilled artisan, having considered the specification in its entirety, would have no difficulty ascertaining the scope of the invention recited in claims 1, 9-14, 16, 18, and 20. Therefore, the rejection of claims 1, 9-14, 16, 18, and 20 under the second paragraph of 35 U.S.C. § 112 is not sustained.

Turning to a consideration of the Examiner's prior art rejections, we note at the outset that Appellants' arguments in

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response to the Examiner's prior art rejections of the appealed claims are organized according to a suggested grouping of claims indicated at page 9 of the Brief. We will consider the appealed claims separately only to the extent separate arguments for patentability are presented. Any dependent claim not separately argued will stand or fall with its base claim. Note In re King, 801 F.2d 1324, 1325, 231 USPQ 136, 137 (Fed. Cir. 1986); In re Sernaker, 702 F.2d 989, 991, 217 USPQ 1, 3 (Fed. Cir. 1983).

We consider first the Examiner's 35 U.S.C. § 102(b) rejection of claims 1, 2, 6, 8-10, and 14-20 based on Stevens. Anticipation is established only when a single prior art reference discloses, expressly or under the principles of inherency, each and every element of a claimed invention as well as disclosing structure which is capable of performing the recited functional limitations. RCA Corp. v. Applied Digital Data Systems, Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir.); cert. dismissed, 468 U.S. 1228 (1984); W.L. Gore and Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 1554, 220 USPQ 303, 313 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

With respect to independent claim 1, the representative claim for Appellants' first suggested grouping of claims subject to this rejection (including claims 1, 2, 6, 8-10, and 14-17), the Examiner

indicates (Answer, pages 6 and 7) how the various limitations are read on the disclosure of Stevens. In particular, the Examiner directs attention to the illustration in Stevens' Figure 2.1 along with the accompanying description at pages 21-23 of Stevens.

After reviewing the Examiner's analysis, it is our opinion that the stated position is sufficiently reasonable that we find that the Examiner has at least satisfied the burden of presenting a prima facie case of anticipation. The burden is, therefore, upon Appellants to come forward with evidence and/or arguments which persuasively rebut the Examiner's prima facie case. Only those arguments actually made by Appellants have been considered in this decision. Arguments which Appellants could have made but chose not to make in the Briefs have not been considered and are deemed to be waived [see 37 CFR § 41.37(c)(1)(vii)].

Appellants' arguments in response to the rejection of representative claim 1 assert that the Examiner has not shown how each of the claimed features are present in the disclosure of Stevens so as to establish a case of anticipation. Initially, Appellants attempt to draw a distinction (Brief, pages 11 and 12; Reply Brief, pages 2 and 3) between the disclosure of Stevens and appealed claim 1 by asserting that, unlike the claimed invention which is directed to radio access networks involving mobile

terminals, Stevens is concerned with fixed landline router networks.

After reviewing the Stevens reference in light of the arguments of record, we are in agreement with the Examiner (Answer, pages 16 and 17) that Appellants' arguments are not commensurate with the scope of representative claim 1. As asserted by the Examiner, there are simply no limitations in appealed claim 1 directed to wireless networks or mobile terminals. In our view, Appellants' arguments improperly attempt to narrow the scope of the claim by implicitly adding disclosed limitations which have no basis in the claim. See In re Morris, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027-28 (Fed. Cir. 1997).

We further find to be unpersuasive Appellants' contention that Stevens lacks a disclosure of the signaling of a protocol identifier to a second protocol layer in a protocol stack. According to Appellants, no such signaling occurs in Stevens, either because the asserted fixed nature of the system of Stevens has no need for protocol signaling (Brief, page 12), or the lower protocol layer in Stevens is indifferent, oblivious, and does not understand what has been received (Reply Brief, pages 3 and 4).

Appellants' arguments to the contrary notwithstanding, however, we find no error in the Examiner's interpretation of the

disclosure of Stevens as particularly expressed in the responsive arguments portion of the Answer (pages 17 and 18). As pointed out by the Examiner, Stevens discloses that a protocol identifier, i.e., the type field which is part of the network layer (first layer) IP datagram, is passed on and signaled to the link layer (second layer) where it is encapsulated into an Ethernet frame. To whatever extent Appellants may be correct that the second layer in Stevens has no need for the protocol identifier data, the fact remains that such data is identified and sent, i.e., signaled, to the second layer. In other words, the fact that a recipient may disregard sent data which is marked and identified does not belie the fact that such marked data was in fact signaled to such recipient. We further agree with the Examiner that, although Appellants' disclosed invention may describe processing operations which may be performed on the signaled data by the second stack layer, no such processing is required by the claimed invention.

It is also our opinion that Appellants' arguments at page 3 of the Reply Brief have misinterpreted the Examiner's position relative to the claimed requirement of signaling a protocol identifier from a first protocol layer to a second protocol layer. Contrary to Appellants' arguments, we find nothing in the Examiner's stated position in the record before us that would

indicate that Appellants' position would be correct if claim 1 included limitations directed to the availability of the protocol identifier to other layers in the same stack. It is apparent to us that the position articulated by the Examiner is that the specific language argued by Appellants is not in claim 1, and not that the claim would be allowable if such language were included, especially in view of the fact that the Examiner has detailed exactly how the disclosure of Stevens meets the requirements of claim 1.

In view of the above discussion, since all of the claimed limitations are present in the disclosure of Stevens, the Examiner's 35 U.S.C. § 102(b) rejection of representative independent claim 1, as well as dependent claims 2, 6, 8-10, and 14-17 grouped together with claim 1 and not separately argued by Appellants, is sustained.

We also sustain the Examiner's 35 U.S.C. § 102(b) rejection of independent claims 18-20 based on Stevens. Although Appellants have grouped these claims separately (Brief, page 9), the arguments in response to the Examiner's rejection essentially reiterate those made with respect to claim 1, i.e., the alleged failure of Stevens to disclose the signaling of a protocol identifier from a first stack layer to a second stack layer. For all of the reasons discussed supra, we find these arguments to be unpersuasive. We

also find no error in the Examiner's assertion that Stevens provides a teaching of utilizing protocol stack framework for communicating among plural communication systems (e.g., Figure 4.2) which, in our view, satisfies the sending device feature of claim 18, the receiving device feature of claim 19, and the plural communication device feature of claim 20.

Turning to a consideration of the Examiner's 35 U.S.C. § 102(b) rejection of representative claim 1, and its dependent claims 7, 11, and 12, based on Amri, we sustain this rejection as well. We are in agreement with the Examiner's analysis of the operation of Amri and the conclusions drawn therefrom as expressed at page 21 of the Answer. As pointed out by the Examiner, Amri describes the signaling of data including a protocol identifier PID from the IP protocol layer to the X.25 protocol layer as implemented by the IP to X.25 Encapsulation module (IXE). As with the Stevens reference discussed previously, it is our view that the described operation of the Amri reference satisfies the claimed requirement of signaling to a second protocol layer a protocol identifier determined in accordance with a first protocol layer.

Similarly, we also sustain the Examiner's 35 U.S.C. § 102(b) rejection, based on Gleeson, of representative claim 20, as well as claims 21-24 grouped together with claim 20 and not separately

argued by Appellants. In our view, the disclosure at column 14, lines 17-59 of Gleeson, which describes the encapsulation of the Compression ID field, i.e., the protocol identifier, as determined in accordance with first layers in a stack and the signaling to second layers in a stack discloses the claimed invention. We agree with Appellants' argument (Brief, page 17) that the operation of Gleeson is similar to that of Amri and, as such, as pointed out by the Examiner (Answer, page 22), in fact satisfies the requirements of representative claim 20.

Lastly, we also sustain the Examiner's 35 U.S.C. § 103(a) rejection of claims 3-5 based on Stevens. In asserting the Examiner's failure to establish a prima facie case of obviousness, Appellants reiterate their arguments directed to Stevens' alleged lack of disclosure of the signaling of a protocol identifier to second layers in a protocol stack, which arguments we found to be unpersuasive as discussed supra.


In summary, we have not sustained the Examiner's 35 U.S.C. § 112, second paragraph, rejection of claims 1, 9-14, 16, 18, and 20. We have sustained the Examiner's 35 U.S.C. § 102(b) rejections of claims 1, 2, 6-12, and 14-24 and the 35 U.S.C. § 103(a) rejection of claims 3-5. Therefore, the decision of the Examiner rejecting claims 1-24 is affirmed-in-part.

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a)(1)(iv) (effective September 13, 2004; 69 Fed. Reg. 49960 (August 12, 2004); 1286 Off. Gaz. Pat. and TM Office 21 (September 7, 2004)).

AFFIRMED-IN-PART

Joseph F. Ruggiero
JOSEPH F. RUGGIERO
Administrative Patent Judge


JOSEPH L. DIXON
Administrative Patent Judge

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